



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,415	11/07/2001	Mitchell D. Eggers	PW 083022 278802	9374

7590

06/13/2005

Pillsbury Winthrop LLP
Intellectual Property Group
Suite 1800
101 W. Broadway
San Diego, CA 92101-8219

EXAMINER

HARRELL, ROBERT B

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/005,415

Applicant(s)

EGGERS, MITCHELL D.

Examiner

Robert B. Harrell

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2001-et al.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-53 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 07 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20040217&20040405
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: see attached Office Action

PD

Art Unit: 2142

1. Claims 1-53 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The claims are more directed to A System For Providing Biological Analyses Results To A Remote Requesting Client Via A Network Who Sends And Receives Biological Samples Via Shipping.
3. The Specification is objected to since page 1 requires updated information including not only current United States Patent Application Numbers but as to their status (i.e., still pending, abandoned, United States Patent Number, exc...).
4. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

6. Claims 1-53 are rejected under 35 U.S.C. 102 (e) as being anticipated by Milosavljevic et al. (United States Patent Application Publication US 2004/0098204A1).
7. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following

citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

8. Starting with claim 27, Milosavljevic taught a system, and the equivalent, comprising:

- a) a sample archive (e.g., see Title) comprising a plurality of sample carriers (e.g., see figure 5 and 5A); each of said plurality of sample carriers configured to support a plurality of discrete sample nodes (e.g., see [0094] and/or [0098]) to [0103];
- b) a database (e.g., see figure 2 (210)) containing data records associated with ones of said plurality of discrete sample nodes and data records associated with biological analyses (e.g., see [0098]);
- c) means for receiving a request (e.g., see figure 2 (205)) from a remote client (e.g., see figure 1 (105)); said request containing information related to performing a selected analysis with selected ones of said plurality of discrete sample nodes (e.g., see figure 2 (205) and/or 4 (405) and [0012]) and ;
- d) a processor responsive to said means for receiving and operative to retrieve selected ones of said data records from said database (e.g., see [0098] to [0103] note ""When a particular sample is requested, automated equipment such as robotics may be used to select and obtain the corresponding DNA sample and provide the sample to the microarray for interrogation." in [0100]);
- e) a sample retrieval apparatus responsive to said processor and operative to retrieve said selected ones of said plurality of discrete sample nodes [0098] to [0103] note ""When a particular sample is requested, automated equipment such as robotics may be used to select and obtain the corresponding DNA sample and provide the sample to the microarray for interrogation." in [0100]);
- f) an assay preparation apparatus responsive to said processor and operative to prepare an assay in accordance with said selected analysis (e.g., see [0134] to [0139]); and,
- g) means for conducting said selected analysis with said selected ones of said plurality of discrete sample nodes and for providing results of said selected analysis to said processor (e.g., see figure 18 and [0149]).

9. Per claim 28, see [0125] to [0127] and [0150] keeping in mind that which was shipped to one person could be shipped back to that person in a packaged sample container after analysis as anticipated by [0095] (i.e., since Client can select sample from database and can conduct client's own analysis, sample must be shipped to client).

10. Per claims 29, 30, 31, 32, 33, 34, 35, 36, 37 and 38, such was the function of the robotics mentioned in [0100] which inherently used optical/laser sensors.

11. Per claims 39 and 40, see Abstract, [0104] and [0109].

12. Per claims 1-26 and 41-53, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above. However, see Abstract that states the samples are biological (inherently needing to be sterile and thus

Art Unit: 2142

washed prior to usage and/or shipping) in nature for biological analyses and figure 1 for a network over which results were encrypted [0119] where the software code recited in [0117]-et seq., was anticipated to be stored on a computer readable medium (Eolas Technologies Inc. v. Microsoft Corp., 73 USPQ2d 1782 (CA FC 2005)) for controlling the robotic portions and the whole of the system at high rates [0094 “96 microarrays within 60 seconds” and thus over 500 per day].

13. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this office action:

a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Milosavljevic et al. (United States Patent Application Publication US 2004/0098204A1) in view of Brignac, JR et al. (United States Patent Application Publication US 2004/0014228A1).

15. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature as the whole of the reference is cited and relied upon in this action.

16. That which was anticipated was obvious and thus the above ground(s) continue herein below and within this Office Action.

17. The applicant might argue the absence of the robotic teachings within Milosavljevic and the limitations as recited in, for example, claims 29-38. However, such was covered in Brignac (e.g., see figures 1-7) who taught a mechanical sample carrier locator and remover (e.g., see figure 4) with clipping tool (e.g., see figure 4 (52)), and optical sensors (e.g., [0018] bar code was laser based optical sensors) or other equivalent identifier means such as a transceiver per [0018 “such as by bar code or other well-known indexing procedures” (i.e., transceiver tags)] as called for, and suggested by Milosavljevic.

18. It would have been obvious to one skilled in the data processing art to have combined the teachings of these references because they both were directed toward the problem of robotically obtaining genetic DNS samples from a sample database as disclosed in each references. Also, one skilled in the art would have obviously noticed Brignac could satisfy the robotic

Art Unit: 2142

requirements of Milosavljevic; the one skilled in the art was Michael E. Hogan from Conroe, Texas a co-inventor of each reference and one skilled in the art.

19. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (571) 272-3896. The fax phone number for all papers is (703) 872-9306.

22. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

A handwritten signature in black ink, appearing to read 'R. B. Harrell', is written over the printed name.

ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142